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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,220	10/28/2003	William R. Raap	07184-00049	4948
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DOWNS RACHLIN MARTIN PLLC 199 MAIN STREET P O BOX 190 BURLINGTON, VT 05402-0190			NGUYEN, SON T	
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			3643	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/695,220	Applicant(s) RAAP ET AL.	
	Examiner Son T. Nguyen	Art Unit 3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13,15-18,20-27 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13,15-18,20-27 and 33-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1,33,34,36** are rejected under 35 U.S.C. 102(b) as being anticipated by Young (1689418).

For claim 1, Young teaches a device comprising a container having an exterior including a bottom wall and a sidewall extending upward from the bottom wall and defining an opening; and a rodent deterrent (either ref. 12 or the vinegar in the coating) secured to at least a portion of the exterior of the container. Note, (see Internet article “Pest Control: How to get rid of rats” where they use vinegar to deter rats).

For claim 33, Young teaches wherein the rodent deterrent is distributed over substantially all of the exterior (see figs.).

For claim 34, Young teaches the rodent deterrent is a particulate (line 31).

For claim 36, Young teaches wherein said bottom wall and said side wall are made such that a rodent can gnaw therethrough and said rodent deterrent deters the rodent from gnawing through said bottom wall and said side wall. Note, Young teaches the deterrent includes vinegar, which is a rodent deterrent substance (see Internet article “Pest Control: How to get rid of rats”), therefore, even though the rodent might

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gnaw through the bottom wall of the pot of Young, the rodent will be deterred due to the vinegar.

3. **Claims 1,4,33,35,36** are rejected under 35 U.S.C. 102(b) as being anticipated by Shiraishi (1762082).

For claims 1,4, Shiraishi teaches a device comprising a container 1 having an exterior including a bottom wall and a sidewall extending upward from the bottom wall and defining an opening; and a rodent deterrent 3,4 secured to at least a portion of the exterior of the container. Deterrent 3 is cement which is made out of limestone, which limestone is fragments of marine sediments such as seashells. Deterrent 4 is hardened lava which is sharp material so can deter rodents due to the sharp edges of the lava (see drawings showing sharp edges).

For claim 33, Shiraishi teaches wherein the rodent deterrent is distributed over substantially all of the exterior.

For claim 35, Shiraishi teaches wherein the bottom wall includes an exterior surface and the rodent deterrent is distributed over substantially the entirety of the exterior surface (see fig. 3, ref. 6).

For claim 36, Shiraishi teaches wherein said bottom wall and said side wall are made such that a rodent can gnaw therethrough and said rodent deterrent deters the rodent from gnawing through said bottom wall and said side wall. Note, Shiraishi teaches the deterrent includes limestone, which is a rodent deterrent substance because limestone is made from seashell fragments similar to that of Applicant's, therefore, even though the rodent might gnaw through the bottom wall of the pot of

Shiraishi, the rodent will be deterred due to the limestone and hardened lava with sharp edges.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1,5-8,11-12,15-17,24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernando et al. (DE019907577C1) in view of Young (as above).

For claim 1, Fernando et al. teach a device comprising a container having an exterior including a bottom wall (1b) and a sidewall (1a) extending upward from the bottom wall and defining an opening. However, Fernando et al. are silent about a rodent deterrent on the exterior wall.

As discussed in the above claim 1, Young teaches a rodent deterrent on the exterior wall of their container. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a rodent deterrent as taught by Young on the exterior of the container of Fernando et al. in order to, not only deterred rodent, but to create an aesthetically pleasing in appearance container (lines 4-6 of Young).

For claims 5-8, Fernando et al. as modified by Young (emphasis on Fernando) further teach the bottom and side walls each comprise elongate biodegradable fibers

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(see abstract of Fernando, fibers are coir fibers). The fibers are bonded together by latex rubber (see abstract).

For claim 11, Fernando et al. as modified by Young (emphasis on Fernando) further teach the bottom wall (1b) having apertures (3) for roots to grow therethrough.

For claims 12,15-17, Fernando et al. teach a system for plants comprising a container having a preformed free-standing walls (1a) and a bottom wall (1b), both walls comprising biodegradable fibers (such as coir fibers) bonded together by latex rubber, the bottom wall includes openings (3); a second soil contained within the cavity (inherent since it is a planting pot which plant lives in soil). However, Fernando et al. are silent about a rodent deterrent attached to the exterior of the container and bulbs. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ bulbs in the container of Fernando et al., depending on the user's preference to grow bulbs or seeds or the like. Fernando's container is designed for germination and planting so one can have a choice to grow whatever desired in the container of Fernando.

As discussed in the above claim 1, Young teaches a rodent deterrent on the exterior wall of their container. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a rodent deterrent as taught by Young on the exterior of the container of Fernando et al. in order to, not only deterred rodent, but to create an aesthetically pleasing in appearance container (lines 4-6 of Young).

For claim 24, Fernando et al. teach a method of planting comprising the step of providing the container as discussed in claim 12. Since the container of Fernando is biodegradable, one could assume it is for planting in the ground so that, eventually, the fibers will degrade and thus, making the container environmentally friendly. However, only an abstract is obtained for translation, it is hard to tell if Fernando's container is intended to be buried in the ground or soil. In any event, it is notoriously well known in the planting industry that containers, be it biodegradable or not, are buried in the soil or ground. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the step of planting the assembly in a second soil in the method of Fernando et al., for such step is notoriously well known in the art and also, it is believe that this is the intention of Fernando's container since the container is biodegradable. However, Fernando et al. are silent about a rodent deterrent attached to the exterior of the container.

As discussed in the above claim 1, Young teaches a rodent deterrent on the exterior wall of their container. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a rodent deterrent as taught by Young on the exterior of the container of Fernando et al. in order to, not only deterred rodent, but to create an aesthetically pleasing in appearance container (lines 4-6 of Young).

6. **Claims 2-3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Young (as above) in view of Kawaguchi et al. (5675933).

Young is silent about a grid closure. Kawaguchi et al. teach a plant container with a grid cover (43) to protect the plants in the container. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a grid cover as taught by Kawaguchi et al. in the assembly of Young in order to protect the plants growing therein.

7. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Young (as above).

Young teaches the deterrent being small particles (line 31) but is silent about the particles being seashell fragments. It is notoriously well known in the plant container industry that various decorative material such as seashell is employed to, not only deterred, but to make the container more pleasing in appearance. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ seashell fragments as the preferred particles for the container of Young, since seashell fragments are notoriously well known to be used on plant container for a more aesthetically pleasing plant container.

8. **Claims 9-10,18,27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernando et al. as modified by Young as applied to claims 1,12,24 above, and further in view of Okii et al. (4945059).

Fernando et al. as modified by Young are silent about a growth enhancer. Okii et al. teach a growth enhancer (such as a fungus) for accelerating growth in plants. The enhancer is released in the soil for the plants to absorb. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a

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growth enhancer as taught by Okii et al. in the assembly of Fernando et al. as modified by Young in order to accelerate the plants' growth. Since it is a container system, the enhance is released from within the container.

9. **Claims 13,25-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernando et al. as modified by Young as applied to claims 12,24 above, and further in view of Kawaguchi et al. (as above).

Fernando et al. as modified by Young are silent about a closure. Kawaguchi et al. teach a plant container with a grid cover (43) to protect the plants in the container. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a grid cover as taught by Kawaguchi et al. in the assembly of Fernando et al. as modified by Young in order to protect the plants growing therein.

10. **Claims 20,22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernando et al. (as above) in view of Okii et al. (as above).

For claim 20, Fernando et al. teach the container system as described above and Okii et al. teach the enhancer as discussed in claim 18; therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a growth enhancer as taught by Okii et al. in the assembly of Fernando et al. in order to accelerate the plants' growth. Since it is a container system, the enhance is released from/within the container.

For claim 22, see claim 18.

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11. **Claim 21** is rejected under 35 U.S.C. 103(a) as being unpatentable over Fernando et al. as modified by Okii et al. as applied to claim 20 above, and further in view of Iwasaki et al. (4844734).

Fernando et al. as modified by Okii et al. are silent about the enhancer being ground-up seashells. Iwasaki et al. teach growth enhance comprising seashell powder (which is ground up seashells). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ seashell powder as taught by Iwasaki et al. as the preferred growth enhancer of Fernando et al. as modified by Okii et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice. In re Leshin, 125 USPQ 416.

12. **Claim 23** is rejected under 35 U.S.C. 103(a) as being unpatentable over Fernando et al. as modified by Okii et al. as applied to claim 20 above, and further in view of Kawaguchi et al. (as above).

Fernando et al. as modified by Okii et al. are silent about a closure. Kawaguchi et al. teach a plant container with a grid cover (43) to protect the plants in the container. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a grid cover as taught by Kawaguchi et al. to cover the container of Fernando et al. as modified by Okii et al. in order to protect the plants growing therein.

Response to Arguments

13. Applicant's arguments filed 10/27/05 have been fully considered but they are not persuasive.

Applicant argued that the base pot of Young with virtual certainty, a clay pot and the decorated Young pot is intended for above ground display. The base clay pot does not need a rodent deterrent. This type of clay is a material that rodents are not likely to gnaw through. In effect, the clay pot itself is a rodent deterrent. To call the cinders a rodent deterrent is nonsensical. In addition, the sidewall of the clay pot is relatively very smooth, thereby inhibiting a rodent from climbing up the sidewall to reach the interior of the pot. Since the decorative cinders do not provide any rodent deterrence function, Applicant assert that it is not reasonable to consider the cinders a rodent deterrent.

A clay pot is not made out of plaster of Paris, aluminum bronze and vinegar (see col. 28-30 of Young), despite Applicant's "virtual certainty" that the pot of Young is a clay pot. Clearly from Young's specification that this is not a clay pot as alleged by Applicant. Although Young's pot is stated as ornamental, it is indeed capable of being buried in the ground if one wishes to do so. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Young clearly anticipates every teaching of Applicant's claimed invention,

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therefore, there is nothing structurally difference to prevent Young's pot from not being buried in the ground.

As for the sidewall being smooth, this argument has nothing to do with anything because the sidewall of the pot of Young is obviously being covered by the cinders so the rodent probably will never really touch the sidewall in order to climb up the pot. Therefore, it is irrelevant whether the wall is smooth or not. Clearly, without the cinders, the rodent may gnaw the sidewall and into the pot, thus, the cinders are definitely rodent deterrence device. The cinders definitely make it more difficult for a rodent to gnaw the pot.

Applicant argued that if the Young cinders are anything relative to rodents, they are rodent climbing aids that due to their rough edges and spaces therebetween, would tend to help rodents climb the outside of the pot so that they can reach the plants in the pot.

If these rough edges help rodents to climb into the pot, then Applicant's invention does the same. Applicant employs seashell fragments to produce sharp edges to the outside wall of the pot so that a rodent would be deterred from climbing up the pot (see Applicant's specification, page 5, [0018]. How is this any different from the rough edges of the cinders of Young? As similar to Applicant's, the rough edges of the cinders would deter a rodent from climbing up the pot.

Applicant argued that claim 33 requires that the rodent deterrent be distributed over substantially all of the exterior of the device.

Claim 33 states "substantially all of said exterior", therefore, substantially means all most all but not all, so the cinders of Young cover all most all but not all of the pot. In addition, when one set the bottom wall on the ground or a support surface, the bottom wall is not exterior because it is being cover by the sidewall and cannot be seen, thus, since the claim said substantially all of the exterior, the exterior is just the sidewall and the rim.

Applicant argued that combining Fernando et al. and Young would require hindsight of the present invention.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argued that the combination of Fernando and Young would destroy some of the teachings of Fernando because the lower portion of Fernando's pot has apertures to inhibit degradation of the fibers and to inhibit a buildup of water inside the pot. If one were to apply Young's plaster of Paris/decorative cinder decoration to the Fernando pot, it would no longer have these characteristics.

Applicant's claim calls for at least a portion of the pot will be covered by the rodent deterrent so one of ordinary skill in the art studying Fernando and Young would probably only apply the cinders of Young to only at least a portion of the pot of Fernando, thus, leaving the lower portion of the pot as intended for inhibit degradation and water buildup. Even if applied the cinders to the whole pot of Fernando, the apertures will still exist to inhibit degradation and water buildup because Young does not state that the cinders decoration is waterproof or air-impermeable, thus, roots can still grow through the gap in the cinders. In addition, Applicant acknowledged on page 6 of the response that the cinders do produce spaces or gaps to help rodents to climb up the pot, therefore, the apertures are there and still do what they are intended to do.

Applicant argued that each of the Fernando and Okii references are completely silent on the growth enhancer being attached to the container or the enhancer being released from the container.

It is true that Fernando does not teach growth enhancer, thus, that is why Okii is combined with Fernando for the teaching. Okii teaches the fungi in the soil, the soil in the pot, thus, the fungi is attached to the pot. In addition, the fungi dissipate because the fungi is in the solution and when the solution is spray or applied into the soil, the solution will soak to the wall of the pot.

Conclusion

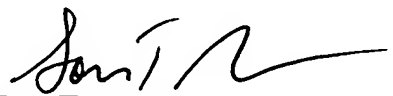
14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 571-272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Son T. Nguyen